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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,841	02/08/2006	Norbert Nessler	2005-042	8532
27569	7590	08/03/2010	EXAMINER	
PAUL AND PAUL 2000 MARKET STREET SUITE 2900 PHILADELPHIA, PA 19103			HUPCZEY, JR, RONALD JAMES	
			ART UNIT	PAPER NUMBER
			3739	
			NOTIFICATION DATE	DELIVERY MODE
			08/03/2010	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

INFO@PAULANDPAUL.COM

claire@paulandpaul.com

fpanna@paulandpaul.com

### Office Action Summary

**Application No.**

10/528,841

**Applicant(s)**

NESSLER, NORBERT

**Examiner**

RONALD HUPCZEY, JR

**Art Unit**

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 May 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2 and 4-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Applicant's amendments and remarks, filed on May 4<sup>th</sup>, 2010, have been fully considered by the Examiner. Claims 1-2 and 4 - 20 are currently pending with claim 3 cancelled and claims 1-2 and 4 - 20 amended. Applicant's amendments to the specification obviate the previously filed objections to the specification. Applicant's submission of the replacement drawing sheets obviates the previously filed objections to the drawings. Applicant's amendments to the claims are noted as well as their response in the remarks. As a result, the claim objections have been obviated. The following is a complete response to the May 4<sup>th</sup>, 2010 communication.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-2 and 4-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, lines 6-7 recite "... and consisting of at least two resistances" therein. This limitation is seen by the Examiner upon further review as unclear rendering the scope of the claim unascertainable. MPEP 2111.03 addresses the use of "consisting of" in the body of a claim. It states that "The transitional phrase 'consisting of' excludes any element, step or ingredient not specified in the claim. *In re Gray*, 53 F.2d 520, 11 USPQ 255 (CCPA 1931)". Additionally, the MPEP states that "When the phrase 'consists of' appears in a clause of the body of a claim, rather than immediately following the preamble, it limits only the element set forth in that clause; other elements are not excluded from the claim as a whole. *Mannesmann Demag Corp. v. Engineered*

*Metal Products Co.*, 793 F.2d 1279, 230 USPQ 45 (Fed. Cir. 1986)". In light of the established view on the phrase "consisting of" highlighted above, it is the Examiner opinion that the phrase "consisting of at least two resistances" is contradictory since "at least two" establishes an opened-ended number of resistances to be included whereas "consisted of" requires a close-end relationship. The Examiner notes that the use of the "comprising of" phrase would seem to be more appropriate for the desired recitation in the claim. Claims 2 and 4-13 are rejected due to their dependency on claim 1. Appropriate correction is required.

Regarding claims 14 and 15, each of these claims contains the at-issue "consisting of at least two resistances" limitation as in claim 1. As noted in the rejection of claim 1 above, such a limitation is seen as being unclear. As a result, claims 14 and 15 are rejected for the same reasoning as presented in the rejection of claim 1. Claims 16-20 are rejected due to their dependency on claim 15. Appropriate correction is required.

Again, regarding claim 1, the claim has been amended to read "that at least one resistance of the equivalent resistance circuit is formed by a reactive resistance representing the hypodermis including fatty tissue for varying the thickness of the hypodermis including fatty tissue, without an increase in temperature" therein. It is the Examiner's position that while it is clear from the Remarks the intent of the amendment, in context of the claim, it is unclear since the "without an increase in temperature" is not tied to a certain structure or layer of human skin. Applicant states in the Remarks that "the effective resistance of the hypodermis may be dimensioned also for a high percentage of fat without an increase in temperature" on page 14 and also states that "a high percentage of fat may be simulated without reaching a too high temperature in the hypodermis part, which would be the case when using only resistances". As the claim is currently written, it

is unclear if there is no temperature rise in general in the hypodermis, no temperature rise from a baseline regardless of how high a fat content is represented or no temperature rise sensed by the thermocouple. It is for this reasoning that the Examiner believes the scope of the claim is unclear. Claims 2 and 4-13 are rejected due to their dependency on claim 1. Appropriate correction is required.

Regarding claim 8, the claim currently recites therein "that each peripheral impedance circuit is connected to the terminal of the horizontal equivalent resistance, which is unconnected at the periphery of the equivalent resistance circuit associated with the measuring electrode situated at the periphery of the measuring surface". Claim 8 is dependent from claim 7 which is dependent from claim 5 which is dependent upon either claim 1 or claim 2. In each of the claims of the dependency chain for claim 8, none recite the limitation of "a terminal of a horizontal equivalent resistance" or even "a horizontal equivalent resistance" to form antecedent basis for the limitation in lines 2-3 of "...is connected to the terminal of the horizontal equivalent resistance which is unconnected at the periphery". While Applicant states on page 11 of the Remarks that "Antecedence for claim 8 resides in claims 6 and 7, claim 6 cannot be relied upon to show antecedence for claim 8 since claim 6 is not in the dependency chain for claim 8. Additionally, upon review of the limitations of claim 7 and in considering the inherent characteristics of the device set forth therein, it is the Examiner's position that one of ordinary skill in the relevant art would not consider "the terminal" or "the horizontal equivalent resistance" as inherent components of the previously recited equivalent resistance circuits. In stating that such a characteristic would be inherent to the equivalent resistance circuit would be stating that *all* equivalent resistance circuits would have a terminal and a horizontal equivalent. It

would be clear to one of ordinary skill in the art that such an arrangement is not inherently require nor implicated by the claims 1, 2, 5 and 7. As a result, it remains the Examiner's position that lines 2-3 fail to have antecedent basis in the parent claims.

Regarding claim 9, the claim currently recites in lines 4-11 "...the horizontal equivalent resistances, and to the terminal of a vertical peripheral resistance which corresponds to the second vertical equivalent resistance, wherein the other ends of the horizontal peripheral resistances are connected to the horizontal equivalent resistance or the horizontal peripheral resistance of the equivalent resistance circuits or peripheral cells adjacent in the column or row directions and wherein the other terminal of the vertical peripheral resistance is connected to ground via the reactive resistance." Claim 9 is dependent on claim 7 which is dependent from claim 5 which is dependent from claim 1 or 2. In each of the claims of the dependency chain for claim 9, the limitations of "the horizontal equivalent resistances" in line 5, "the terminal" of a vertical peripheral resistance in line 5, the "second vertical equivalent resistance" in line 6, "the horizontal equivalent resistance" in lines 7-8 and "the other terminal" of the vertical peripheral resistance in lines 9-10 do not have antecedent basis. It is noted that Applicant has stated on page 11 that antecedence for claim 9 resides in claim 7. Upon review of the limitations of claim 9 and in considering the inherent characteristics of the device set forth therein, it is the Examiner's position that one of ordinary skill in the relevant art would not consider "each of the at issue limitations" as inherent components of the previously recited equivalent resistance circuits and vertical peripheral resistance respectively. In stating that such a characteristic would be inherent to the equivalent resistance circuit would be equivalent to stating that *all* equivalent resistance circuits would have a terminal and a horizontal equivalent. It would be clear to one of ordinary

skill in the art that such an arrangement is not inherently require nor implicated by the claims 1, 2, 5 and 7. As a result, it remains the Examiner's position that each of the at-issue limitations indicated above fail to have antecedent basis in the parent claims.

Regarding claim 16, the claim recites therein "... that the through holes are arranged concentrically with the centers of the measuring electrodes". This limitation was at issue in the previous office action and remains at issue. Specifically, the Examiner has previously stated that there is insufficient antecedent basis for the limitation of "the centers of the measuring electrodes". It was noted that no shape or arrangement of each of the measuring electrodes appears in the claims which would allow the Examiner to infer that there inherently existed a center for each of the measuring electrodes. The Examiner stands behind this assertion. Applicant has contended on page 11 of the Remarks that "An electrode inherently (implicitly) has a 'center' portion or 'center spot' which is the center of the physical electrode's structure. This language is implicitly clear to one of ordinary skill". The Examiner respectfully disagrees with this characterization because without a set shape or structural arrangement of each of the electrodes, it would be impossible to state within the broadest reasonable interpretation afforded to one of ordinary skill in the art that "an electrode" or "a plurality of measuring electrodes" would inherently have a "center" or "center spot". In just stating "a plurality of measuring electrodes" in claim 15, the electrodes can be of any known shape or structural arrangement. Claim 16, in reciting the "are arranged in the form of a matrix" limitation, narrows the structural arrangement to some formation of electrodes in rows and columns but does not give rise to the shape of the electrode itself. To this end, the Examiner asks Applicant to consider the shape of the two electrodes provided in the drawings below.



The electrode shape on the left denotes only a ring shaped electrode which does not have a center contained thereon. Also, while the shape to the right is a more unorthodox shape and not normally found in the prior art, it would be difficult for one of ordinary skill in the art to readily point to what constitutes the "center spot" of that electrode shape. It is therefore the Examiner's position that the limitation of "the centers of the measuring electrodes" fails to have antecedent basis in the claims for at least the reasoning presented above. Claims 17-20 are rejected due to their dependency on claim 16. Appropriate correction is required.

***Response to Arguments***

4. Applicant's arguments, see pages 12-16 of the Remarks, filed May 4th, 2010, with respect to claims 1-2, 4-10 and 13 have been fully considered and are persuasive. The rejection of the claims under 35 U.S.C. 103(a) has been withdrawn. It is noted that upon entry of the amended claims of May 4<sup>th</sup>, 2010, claim 1 now positively recites that the equivalent resistance circuit represents at least the hypodermis including fatty tissue and that at least one of the at least two resistances is formed of a reactive resistance which allows for the equivalent resistance to be varied dependent upon the thickness of the hypodermis including fatty tissue that the equivalent resistance circuit is representing.



8. Applicant's arguments filed May 4<sup>th</sup>, 2010 regarding the rejection of claims 8, 9 and 16 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph have been fully considered but they are not persuasive. The Examiner has responded to each of these arguments in the above rejection of each claim under the 35 U.S.C. 112 section. It is the Examiner's belief that these rejections are fully responsive to Applicant's arguments set forth in the May 4th remarks.

***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RONALD HUPCZEY, JR whose telephone number is (571)270-5534. The examiner can normally be reached on Monday - Friday, 9 A.M. to 5 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ronald J. Hupczey/  
Examiner, Art Unit 3739

/Michael Peffley/  
Primary Examiner, Art Unit 3739

RJH